

### REMARKS

A prior Office Action was mailed on July 17, 2002. A prior response to that prior Office Action was mailed on October 17, 2002.

A second Office Action was mailed December 24, 2002.

In the second Office Action, regarding the Claims, Claims 1-17 were rejected under 35 U.S.C. 103(a).

In this Response, regarding the Claims, remarks are directed to the rejections.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Claims 1-17 are now pending in the present application. Reconsideration is requested. In addition to the above amendments, the Applicant makes the following remarks regarding individual issues:

### THE APPLICANT'S TIME TO RESPOND

The last Office Action was mailed on December 24, 2002. The three-month initial deadline for responding without having to pay a penalty fee ended on March 24, 2002. The Applicant hereby encloses a 1-month small entity extension fee. The initial deadline is thus extended to April 24, 2002. In determining whether this document is timely filed, the Patent Office is asked to note the Applicant's Certificate of Mailing in conjunction with 37 C.F.R. § 1.8.

## THE SECTION 103(A) OBVIOUSNESS REJECTION

The Commissioner rejected Claims 1-7, 9-11, 13-15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,304,945 ("Anderson"). The Commissioner rejected Claims 8, 12, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of U.S. Patent No. 3,103,933 to Sanzo ("Sanzo").

In the case of a Section 103(a) obviousness rejection, it is the Commissioner's initial burden to put forward a prima facie case. MPEP 2142, 2143; In re Mayne, 41 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1997). The prima facie case requires: (1) "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings"; (2) "there must be a reasonable expectation of success"; (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP 2143

Section 103 requires analysis of a claimed invention as a whole, and it is "immaterial to the issue...that all of the elements are old in other contexts. ... Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness." The Gillette Co. v. S.C. Johnson & Son Inc., 16 USPQ2d 1923 (Fed. Cir. 1990); In re O'Farrell, 7 USPQ2d 1673, 1680 (Fed. Cir.

1988). The foundational facts for the prima facie case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art. Graham v. John Deere Co., 383 U.S. at 17-18; Miles Lab., Inc. v. Shandon Inc., 27 USPQ2d 1123, 1128 (Fed. Cir. 1993).

Moreover, "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416 (Fed. Cir. 1986).

Here, one skilled in the art reading Anderson and Anderson in view of Sanzo would not be motivated to discover or build Applicant's invention. As such Anderson and Anderson in view of Sanzo neither renders unpatentable, nor is analogous to, Applicant's invention.

**The 1/64" to 1/4" slit width range.**

The Commissioner previously cited Anderson in a prior Office Action. Anderson teaches a hair treatment cap for selectively treating locks of hair, provided with a plurality of clamping means. A clamp is made of a fixed element, which is a substantially rigid metal, plastic, or like substance, in conjunction with a movable element which acts like the opening of a jaw for the clamp. Anderson requires that "the lock of hair is firmly clamped in position with a substantially fluid-tight seal whereby there is little or no likelihood that treating solution will seep downwardly through the clamp into contact with hair beneath the opening."

See Anderson, page 3, lines 20-28. According to Anderson, the clamp elements are held in clamping engagement by locking means, with a latch having a cam-shaped sector, which rotates, and which holds hair in a fluid type manner "preventing seepage of the treating agent under the cap". See Anderson, page 3, lines 29-41. Suitable clamps are shown to include a bifurcate spring clip with two jaw elements.

The Commissioner reasserts Anderson in the latest Office Action. The Commissioner contends that Anderson discloses the claimed invention except for slits having width range of  $1/64$ " to  $1/4$ ". The Commissioner contends that modifying slits to have that width range would be obvious. The Commissioner asserts the same grounds in rejecting the method claim of Claim 13 and 15. The Commissioner specifically points out that Anderson discloses that its clamps "clamp the lock of hair in fluid-tight engagement". See Office Action, dated December 24, 2002, at page 5 (quoting Anderson).

The slit width of  $1/64$ " to  $1/4$ " limitation is not present in Anderson nor rendered obvious by Anderson because Applicant's invention does not have a clamp, as taught in Anderson. In Applicant's invention, the width remains unchanged in use as the slit is not closed. Anderson requires that the slits be clamped shut. When clamped shut they will not have width of  $1/64$ " to  $1/4$ ", as taught by Applicant. The requirement in Anderson of firmly shutting clamps precludes the slit width of Applicants' invention. Anderson specifically precludes having such a wide gap, stating "the lock of hair is firmly clamped in position with a substantially fluid-tight seal". See Anderson, page 3, lines 23-27. Anderson

specifically includes in its definition of "slit" the jaw like elements of the clamps.

See Anderson, page 4, lines 34-35.

The Commissioner stated that finding an optimum range is within the level of those skilled in the art. However, optimum range for Anderson's firmly sealed jawlike clamps will not be the optimum range for Applicant's slits. Anderson specifically teaches a zero, or as close to zero, width range when closed as possible. Applicant specifically teaches a range of 1/64" to 1/4" width at all times, with the only exception being for the ZIP LOCK closure, in which case the slits are only "partially" closed. It is submitted that an optimum range for Anderson will not correspond to an optimum range for Applicant's invention, and thus, Applicant's range is not rendered obvious by Anderson in any respect. If anything, the firmly sealed jawlike clamps of Anderson teach away from the gapping width range of Applicant's invention.

#### **The Zig-zag shape**

The Commissioner also contends that, in regarding to Claims 5 and 10, giving the slits a zig-zag shape would have been an obvious matter of design choice, on the assertion that "applicant has not disclosed that the zig-zag shape solves any stated problem or is for any particular purpose." The Commissioner further states that "the zig-zag shapes does not appear to be anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious." The Commissioner asserts the same grounds in rejecting the method claim of Claim 14 and 15.

Applicant's invention, with respect to the zig-zag, serves the purpose of imparting a zig-zag design to the hair of the person whose hair is being colored. See Specification p. 2, Ins 19-22, p 3, Ins 8-11 & 23-25, pg 4, Ins 14-20, pg 6, Ins 9-15. Thus, it has a functional purpose not addressed by either Anderson or Sanzo, nor mentioned or even suggested by Anderson or Sanzo.

Moreover, Anderson is contrary to a zig-zag shape because the straight clamps disclosed and explicitly taught in Anderson preclude a zig-zag shape. Specifically, Anderson cannot work with a zig-zag slit. Anderson precludes the use of a zig-zag slit because of its clamping requirement. Applicant explicitly teaches a zig-zag slit. Accordingly, the rejections should be removed.

**The ½" to 2" in slit spacing.**

With respect to Claims 6 and 9, the Commissioner contends that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to space the slits apart with a spacing in the range of ½" to 2" on the contention that "it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art."

The Commissioner stated that finding an optimum range is within the level of those skilled in the art. However, optimum range between Anderson's jawlike clamps will not be the optimum range between Applicant's slits. It is submitted that an optimum range for Anderson will not correspond to an optimum range for Applicant's invention, and thus, Applicant's range is not rendered obvious by Anderson in any respect.

**The ZIP LOCK closure.**

The Commissioner reasserts Anderson in view of Sanzo with respect to Claims 8, 12, and 16 on the contention that it would have been obvious to modify Anderson with slits having a ZIP LOCK closure of Sanzo.

The Commissioner stated that "Sanzo discloses a similar device" and that it would have been obvious to modify Anderson to have the closure of Sanzo. See Office Action at page 4-5. The Commissioner stated that "Sanzo is similar to both Applicant's invention and to Anderson". See Office Action at page 6. Specifically, the Commissioner contends that Sanzo has a ZIP LOCK type closure, which Anderson can be modified to include, and therefore that modified combination would render obvious Applicant's invention.

First, Sanzo does not teach a ZIP LOCK type closure. To the contrary, the Commissioner is directed to Sanzo, which describes its closure element as follows:

"Along each of these edges, there is provided a groove within which is received a strip or rib of sponge rubber which strips come together when the container is closed to seal it and to grip and hold the hair which is held within the container....

...

"These edges are similarly provided each with a groove and a strip or rib of sponge rubber, for example, in the grooves which strips come together to seal and grasp and hold the lock or strands of hair when the container is closed."

See Sanzo, col. 2, Ins 28-32 & col. 3, Ins. 32-37. Thus, it is clear that Sanzo does not teach a ZIP LOCK type closure.

Moreover, the Commissioner is directed to Applicant's invention, wherein Applicant describes its ZIP LOCK type closure, which is only partially closed at any time, as follows:

"Alternatively, the slits can be configured in a zip lock fashion such that the slit can be **partially closed** to tighten the slit upon the shank of the hair creating the **additional firmness needed to keep hair secure** when pulled through the slits. Zip lock refers to **interlocking seams** for a linear press-closure which **holds together by interference** between two linear elements of either side of the seal, with or without a movable closure element, such as those sold under the trademark ZIPLOC."

Specification, page 5, lns 22-28. As the Commissioner can see, Applicant's invention requires a press closure of "interlocking seams" held together by "interference" between two linear elements "of either side of the seal". Applicant's invention makes no mention of a rubber or sponge gripper. Sanzo makes no mention of "interlocking seams" and "interference".

Further, Applicant's invention has the slit only "partially closed", whereas in both Sanzo and Anderson, the clamping apparatus are shut tight.

Further, Anderson and Sanzo cannot be combined. First, Sanzo is not similar to Applicant's invention or to Anderson. Anderson teaches a head cap that goes over a head, with a plurality of slits made of jaw elements which clamp tightly shut on hair locks. Conversely, Sanzo teaches a hair enclosure that does not fit over the head, but rather, individual locks of hair are trapped in an enclosed container and treated. The hair locks in Sanzo are sealed within the container. Second, there is no motivation to combine Anderson and Sanzo, and there is no reasonable likelihood that if such a combination were attempted that it would actually work. Sanzo and Anderson cannot be combined as suggested by



the Examiner. Anderson specifically requires that hair locks be clamped, with the ends of the hair extending freely beyond the clamp. This thus forecloses the use of Sanzo, which requires hair to be sealed within a container, not extending freely. Accordingly, because Anderson expressly precludes a combination which would include Sanzo, the rejections must be removed.

Here, Sanzo teaches a hair enclosing contraption, which traps individual locks of hair for treatment—the antitheses of a cap where individual locks of hair are pulled through and are free. Sanzo would not lead a practitioner either to practice Anderson or Applicant's invention.

Moreover, the Commissioner is reminded that the modifications to Anderson by Sanzo that the Commissioner asserts are required to come from the references themselves, as is the reasonable degree of success of such a combination. See MPEP 2143. The Commissioner is further reminded that “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.” Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416 (Fed. Cir. 1986).

Here, the Commissioner has not made an attempt to point out where in either Sanzo or Anderson there is any motivation to modify Anderson by an element in Sanzo. The Commissioner has not made any attempt to point out how Anderson could, in fact, be mechanically modified by Sanzo. The Commissioner has not made any attempt to indicate what level of success

should be expected by someone who would attempt to modify Anderson to have the features of Sanzo.

The rejections are respectfully traversed as to all these claims. Applicant respectfully requests that the rejections be withdrawn.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of Claims 1-17 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (360) 750-9931 if it appears that an interview would be helpful in advancing the case. The Applicant respectfully submits that the rejection of the pending claims must be withdrawn, and that this application is in condition for allowance. Such is earnestly requested.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

[INSERT CLAIMS SHOWING AMENDMENTS AND NEW CLAIMS]

No Changes have been made